

REMARKS

I. Status Of The Claims

In the Office Action of September 2, 2011 ("the Office Action"), the Examiner took the following actions:

- i.) objected to claims 25 and 27 due to informalities;
- ii.) rejected claims 1-8, 10-16, 18-26, 28-34, and 36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,003,030 to Kenner et al. ("*Kenner*");
- iii.) rejected claims 9 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner* in view of U.S. Patent No. 6,377,996 to Lumelsky et al. ("*Lumelsky*"); and
- iv.) rejected claims 17 and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner* in view of U.S. Patent No. 7,076,552 to Mandato ("*Mandato*").

By this Amendment, Applicants amend claims 25 and 27 solely to address the Examiner's objections. No prohibited new matter has been introduced. Upon entry of the above amendments, claims 1-36 will remain pending and under examination.

Claims 38-45 are withdrawn from consideration.

Applicants respectfully traverse the rejections and submit that the pending claims are allowable over the prior art of record for at least the following reasons.

II. Claim Objections

In the Office Action, the Examiner objected to claims 25 and 27 due to informalities. Office Action, p. 4. As noted above, Applicants have amended claims 25 and 27 solely to address the Examiner's objections. In view of these amendments, the objections are moot and should be withdrawn.

III. **Rejection Under 35 U.S.C. § 102(b) Based On Kenner**

Applicants respectfully traverse the rejection of claims 1-8, 10-16, 18-26, 28-34, and 36 as being anticipated by *Kenner*. *Kenner* fails to anticipate each and every element of Applicants' claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *see also* M.P.E.P. § 2131. In this case, independent claims 1 and 19 recites features that *Kenner* fails to disclose. Accordingly, the rejection is improper and should be withdrawn.

Kenner fails to disclose, for example, "determining, using the client application on the client and **based on requesting the identical portions of the content**, a performance metric describing an ability for the content source to support the client as measured by the client between each of the at least two of the content sources" and "rendering, using the client application on the client, **the identical portion of the accessed content and a subsequent portion of content that follows the identical portion** of the accessed content from the selected content source," as recited in claim 1 (emphasis added). While *Kenner* may disclose running a set of tests on a "delivery site" in order to rank them (*see Kenner*, col. 13, ll. 1-19), *Kenner* fails to disclose or teach the claimed "determining" or "rendering."

The Office Action asserts that the above subject matter of claim 1 is disclosed by *Kenner* because the "performance metric is [the] SM parameter" and *Kenner* discloses playback of a clip. Office Action, pp. 5-6. Applicants respectfully disagree.

Kenner's "SM" parameter is not a performance metric. In *Kenner*, the "SM" parameter specifies a particular content provider and a group of mirror sites used by that provider. *Kenner*, col. 14, ll. 44-47. In other words, the "SM" parameter is a just list of content sources. Moreover, contrary to the assertions in the Office Action, nowhere does *Kenner* disclose that the "SM" parameter is determined "based on requesting the identical portions of the content," as recited in claim 1.

Even if *Kenner* discloses a performance metric (which it does not), *Kenner* would still fail to disclose "rendering . . . the identical portion of the accessed content and a subsequent portion of content that follows the identical portion of the accessed content from the selected content source," as recited in claim 1. The sections of *Kenner* that the Office Action relies upon to teach the claimed "rendering" are, in fact, deficient and only generally disclose the playback of content. See *Kenner*, col. 14, ll. 20-22; col. 15, ll. 39-46. Nothing in the referenced sections, nor any other section of *Kenner*, discloses the "rendering" element of claim 1.

In view of the foregoing, *Kenner* fails to anticipate independent claim 1 and the rejection of claim 1 is improper and should be withdrawn. Independent claim 19, while different in scope, recites similar features to that noted above for claim 1 and, therefore, is also allowable over *Kenner*.

Claims 2-8, 10-16, 18, 20-26, 28-34, and 36 depend from one of the independent claims and also recite additional distinguishing features. Accordingly, the rejection of these claims is improper and should be withdrawn.

IV. Rejection Under 35 U.S.C. § 103(a) Based On *Kenner* and *Lumelsky*

Applicants traverse the rejection of claims 9 and 27 as being obvious over the combination of *Kenner* and *Lumelsky*. A *prima facie* case of obviousness has not been established.

Claims 9 and 27, in addition to reciting additional distinguishing features, depend from one of independent claims 1 and 19. As noted above, *Kenner* fails to disclose, and does not suggest, the claimed “determining” or “rendering.” The Office Action does not rely upon *Lumelsky* to cure these deficiencies, and *Lumelsky* does not disclose these elements.

Accordingly, the Office Action has failed to present a *prima facie* case of obviousness with respect to claims 9 and 27, and the rejection should be withdrawn.

V. Rejections Under 35 U.S.C. § 102(b) Based On *Kenner* and *Mandato*

Applicants traverse the rejection of claims 17 and 35 as being obvious over the combination of *Kenner* and *Mandato*. A *prima facie* case of obviousness has not been established.

Claims 17 and 35, in addition to reciting additional distinguishing features, depend from one of independent claims 1 and 19. As noted above, *Kenner* fails to disclose, and does not suggest, the claimed “determining” or “rendering.” The Office Action does not rely upon *Mandato* to cure these deficiencies, and *Mandato* does not disclose these elements.

Accordingly, the Office Action has failed to present a *prima facie* case of obviousness with respect to claims 17 and 35, and the rejection should be withdrawn.


CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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